

LAW OFFICES OF
McGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

A PROFESSIONAL LIMITED LIABILITY COMPANY
PATENTS, TRADEMARKS, COPYRIGHTS, AND INTELLECTUAL PROPERTY LAW
8321 OLD COURTHOUSE ROAD, SUITE 200
VIENNA, VIRGINIA 22182-3817
TELEPHONE: (703) 761-4100
FACSIMILE/DATA: (703) 761-2375; 761-2376
E-MAIL: MCGINNGIBB @ AOL.COM / ADMIN @ MCGINNIPLAW.COM
SENDER'S E-MAIL: P MILLER @ MCGINNIPLAW.COM

RECEIVED
CENTRAL FAX CENTER
SEP 27 2005

SEAN M. MCGINN
PHILLIP E. MILLER*
FREDERICK E. COOPERRIDER*
JAMES E. HOWARD*
JAMES N. DRESSER
JOHN J. DRESCH
SCOTT M. TULINO
J. BRADLEY WRIGHT*
*MEMBER OF BAR OTHER THAN VA

September 27, 2005

VIA FACSIMILE
EXPEDITED PROCEDURE

To: Examiner Gerald J. O'Connor.
Group Art Unit No. 3627
U. S. P. T. O.

Facsimile No. 571-273-8300

From: Phillip E. Miller

Facsimile No. 703-761-2375

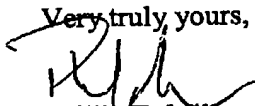
Re: Filing of Notice of Appeal and Appellant's Pre-Appeal Brief Request for Review
U. S. Patent Application Serial No. 09/825,879
Our Ref: YOR.191

Dear Examiner:

Enclosed please find a Notice of Appeal and Appellant's Pre-Appeal Brief Request for Review which should place the above-referenced Application in condition for allowance.

Thank you in advance for your kind consideration of this case.

Very truly yours,


Phillip E. Miller

PEM/lmb
Enclosure

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

RECEIVED
CENTRAL FAX CENTER

Connors et al.

SEP 27 2005

Serial No.: 09/825,879

Group Art Unit: 3627

Filed: April 5, 2001

Examiner: Gerald J. O'Connor

For: SYSTEM AND METHOD FOR RESTOCKING AND REPRICING MERCHANDISE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450
Box AFAPPELLANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Comes now the Appellant and respectfully requests that the Pre-Appeal Brief Conference Panel withdraw the restriction requirement of claim 27 and the rejection by the Examiner of claims 1-13 and 21-26 in the Office Action dated July 27, 2005, and the Advisory Action dated September 19, 2005. This request is filed concurrently with the filing of a Notice of Appeal.

Claim 27 has been withdrawn as being allegedly independent and distinct from the originally claimed invention. Claims 1-13 and 21-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brick et al. (U. S. Patent No. 6,269,342) in view of Adamec et al. (U.S. Patent No. 6,211,773).

I. THE CLAIMED INVENTION

The claimed invention (as recited, for example, in claim 1) is directed to a system for restocking and repricing merchandise. The system includes a shelf label holder including an illuminating device for performing an illuminating function, and a hand-held unit which remotely causes said illuminating device to illuminate under a predetermined condition. Further, the illuminating device includes a plurality of illuminating sections which correspond respectively to locations on a shelf (Application at Figure 2; page 6, lines 1-18). This feature may help guide a store clerk to a correct store location for restocking and/or repricing merchandise (Application at page 2, lines 13-16).

II. THE RESTRICTION REQUIREMENT

The Examiner has failed to show that claim 27 may be withdrawn and not examined. The Examiner alleges that "*the combination as claimed does not require the particulars of the subcombination as claimed because a system in accordance with Invention II need not be capable of remotely causing the shelf label holder to illuminate under a predetermined condition*".

However, under MPEP §806.05(c) an invention may be considered "distinct" only if the combination "does not require the particulars of the subcombination as claimed for patentability". Nowhere has the Examiner made such an allegation. Indeed, the examiner has merely stated that "a system ... need not be capable of remotely causing the shelf label holder to illuminate". Nowhere does the Examiner allege that the system does not need the "shelf label holder" to be patentable. Therefore, Appellant submits that even assuming (arguendo) that the Examiner's statement is correct, the Examiner has failed to meet his burden under MPEP §806.05(c).

Serial No. 09/825,879
Docket No. YOR920000070US1

2

Moreover, MPEP §806.05(c) states that: "[t]o support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search" (emphasis added). Nowhere has the Examiner alleged any reason for insisting on restriction. Indeed, claim 2, like claim 27, recites a "host controller" and thus, it is clearly unreasonable to suggest that examining claim 27 would add any undue burden on the Examiner. Thus, the Examiner has clearly failed to meet his burden under MPEP §806.05(c), and the panel is requested to withdraw this restriction requirement.

III. BRICK AND ADAMEC

The Examiner alleges that Brick would have been combined with Adamec to form the invention of claims 1-13 and 21-26.

However, Brick is directed to a shelf tag associated with a particular product, whereas Adamec is directed to an electronic price label (EPL) system which is intended to allow an operator to control an EPL computer from anywhere in a store (Adamec at col. 2, lines 40-44). Thus, Brick is completely unrelated to Adamec, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight. Further, Appellant would submit that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Brick, nor Adamec, nor any alleged combination thereof teaches or suggests a shelf label holder having an illuminating device which "*comprises a plurality of illuminating sections which correspond respectively to locations on a shelf*", as recited in claim 1. The plurality of illuminating sections may help guide a store clerk to a correct store location for restocking and/or repricing merchandise (Application at page 2, lines 13-16).

The Examiner alleges that these features are disclosed by Adamec but that is incorrect.

1. Adamec Merely Discloses Electronic Price Labels (e.g., Tags) Which Do Not Help Direct A Store Clerk to a Shelf Location

Adamec teaches that hand-held terminals have problems which he allegedly addresses by instead using a remote control device 24 (Adamec at col. 1, line 66-col. 2, line 9). Therefore, **Adamec teaches away from the claimed invention.**

Further, Adamec is directed to an "electronic price label" system, the shortcomings of which are discussed in the Background section of the present Application. Specifically, the labels (e.g., tags) are **expensive and cannot provide the same amount of information** as a paper shelf label (Application at page 2, lines 7-8). Moreover, the Application states that "*like paper labels, such electronic tags do not help guide the store clerk to the correct shelf location*" (emphasis added) (Application at page 2, lines 11-12).

Serial No. 09/825,879

3

Docket No. YOR920000070US1

Nowhere does Adamec even recognize the problem of locating a shelf on which merchandise is located, let alone offer a solution to the problem. Instead, Adamec is merely intended to provide a remote control device that would allow an operator to control an EPL computer from anywhere in a store (Adamec at col. 2, lines 40-44).

2. Adamec Does not Teach or Suggest a HOLDER for Holding a Shelf Label, Let Alone a Holder Having an Illuminating Device

The Examiner is confusing a "shelf label" with a "shelf label holder". That is, it is a "shelf label **holder**" and not necessarily a "shelf label" which includes the illuminating device in the claimed invention. Indeed, as illustrated in Figure 2 of the Application, in the exemplary aspects of claimed invention the shelf label 220 may be merely a paper or plastic label inserted into the shelf label holder 200 (Application at page 5, lines 13-15). That is, the label 220 in the claimed invention may include a simple paper label and is not necessarily an electronic label such as the label 18 in Adamec (e.g., see Adamec at Figure 1).

Indeed, nowhere does the Examiner even allege that Adamec teaches or suggests a shelf label **holder** having an illuminating device, but instead merely alleges that *"the shelf label of Adamec et al. indeed includes a plurality of illuminating sections which are illuminated by remote control of the hand-held unit"*. Appellant respectfully submits that a "shelf label" is completely different from a "shelf label holder". Indeed, Appellant submits that one of ordinary skill in the art would understand a shelf label holder to include a structure for holding a shelf label, and a shelf label to include a label which is held by a shelf label holder. That is, no person of ordinary skill in the art would consider these terms to be interchangeable. Thus, even assuming (arguendo) that the Examiner's allegations are correct, **the Examiner has failed to even allege that Adamec teaches or suggests a holder which includes an illuminating device as in the claimed invention (e.g., see Figure 2 of the Application).**

Moreover, the Examiner does not even allege that Brick would have been modified to include an illuminating device in a shelf label holder, but instead alleges only that Brick would have been modified to "include an illuminating section in the **shelf label**" (emphasis added) (Office Action at page 4). Thus, even assuming (arguendo) that the Examiner's allegations are correct, the Examiner has failed to even allege that Brick and Adamec would have been combined to form a **shelf label HOLDER having an illuminating device.**

3. Adamec Does Not Teach or Suggest an Illuminating Device Having a Plurality of Illuminating Sections

The Examiner attempts to rely on Figures 2A-2B and col. 4, line 32 et seq. in Adamec to support his position that Adamec teaches a shelf label having "a plurality of illuminating sections" as in the claimed invention. Specifically, the Examiner alleges that the indicators 45a and 45b in Adamec provide the illuminating function as in the claimed invention.

However, it is important to understand that Figures 2A-2B depict a remote control device 24 which includes "the **components** of two [labels] represented as portions 50a and 50b"

Serial No. 09/825,879
Docket No. YOR920000070US1

4

(emphasis added) (Adamec at col. 3, lines 66-67). That is, features 50a and 50b are not labels but merely "components" of labels. Indeed, labels in Adamec are identified by the numeral "18" in Adamec, so if Figures 2A-2B depicted labels as alleged by the Examiner, then these drawings would include the identifier numeral "18". However, nowhere do Figures 2A-2B include the numeral "18", but instead use the numerals "50a" and "50b" to distinguish between a label and components of a label.

Moreover, Adamec merely states that these indicators 45a and 45b are "preferably an optional alternative or addition to displaying of acknowledgements by displays 46a and 46b" in the remote control device (Adamec at col. 4, lines 32-34). Adamec states that displays 46a and 46b are used "to signal an operator that EPL computer 12 has executed a desired function in response to a command message from device 24" (Adamec at col. 4, lines 22-24).

That is, Adamec merely teaches that an operator of the remote control device 24 may view the indicators 45a and 45b **on the remote control device 24 (i.e., not on the label 18)** to confirm that the computer 12 has executed a desired function. Thus, **nowhere does Adamec teach or suggest that the remote control device 24 remotely causes an indicator on a label to illuminate.**

Moreover, even assuming (arguendo) that the portions 50a and 50b which may represent components of a label in Figures 2A and 2B may include the indicators 45a and 45b, it is clear that each of the components 50a and 50b include only one indicator, 45a and 45b, respectively. That is, the components 50a and 50b do not include an illuminating device having a plurality of illuminating sections.

Thus, even assuming (arguendo) that the Examiner's allegations are correct that the label 18 includes an indicator (e.g., indicator 45a), **nowhere does Adamec teach or suggest that the indicator includes a plurality of illuminating sections.**

4. Adamec Does Not Teach or Suggest Illuminating Sections Which Correspond Respectively to Locations on a Shelf

Even assuming (arguendo) that Adamec teaches a holder having an illuminating device with a plurality of illuminating sections, Adamec certainly does not teach or suggest illuminating sections which correspond respectively to locations on a shelf, as in the claimed invention.

Again, the Examiner attempts to equate the indicators 45a and 45b in the remote control device 24 with the illuminating device of the claimed invention. However, **nowhere does Adamec teach or suggest that these indicators correspond to locations on a shelf.** Instead, Adamec merely states that indicators 45a and 45b are "preferably an optional alternative or addition to displaying of acknowledgements by displays 46a and 46b" which are used "to signal an operator that EPL computer 12 has executed a desired function in response to a command message from device 24" (Adamec at col. 4, lines 22-24).

Indeed, Appellant would point out that the Examiner has completely ignored this

Serial No. 09/825,879
Docket No. YOR920000070US1

5

limitation in the claims. That is, the Examiner does not even mention this important limitation in his rejection of the claims.

Therefore, the Office Action dated May 20, 2005, was incomplete under 37 C. F. R. 1.104 which states that "[t]he Examiner's action **will be complete** as to all matters" (emphasis added), and MPEP 707.07 which states that "[w]here a claim is rejected for any reason related to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" (emphasis added). Therefore, the Examiner has clearly failed to perform his duties in examining the present Application.

III. CONCLUSION

In view of the foregoing, Appellant respectfully submits that the restriction requirement and rejection are clearly not proper and without basis and, therefore, requests that the Pre-Appeal Brief Conference Panel withdraw the restriction requirement and rejection.

Please charge any deficiencies in fees and credit any overpayment of fees to Assignee's Deposit Account No. 50-0510.

Respectfully submitted,



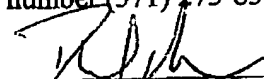
Phillip E. Miller, Esq.
Registration No.: 46,060

Date: 9/27/05

McGinn IP Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Gerald O'Connor, Group Art Unit # 3627 at fax number (571) 273-8300 this 27th day of September, 2005.



Phillip E. Miller
Reg. No. 46,060